

## **REMARKS**

### **Claim Rejections**

Claims 18-19 and 21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Himmel et al. (6,993,319). Claims 1-2, 5-7 and 10-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Son (2005/0197169) in view of Furter et al. (2005/0104732). Claims 14-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Seita (6,973,327) in view of Furter et al. Claims 3, 8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Son and Furter as applied to claims 1, 5 and 10 above, and further in view of Arisawa et al. (2003/0141989). Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Seita and Furter as applied to claim 14 above, and further in view of Arisawa et al. Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel as applied to claim 18 above, and further in view of Arisawa et al.

### **Claim Amendments**

By this Amendment, Applicant has canceled claim 21 and has amended claim 18 of this application to recite that the antenna comprises a “coiled enameled wire.” As a result, **all claims** now recite an antenna comprises a “***coiled enameled wire***” thereby traversing the Examiner’s rejection under 35 U.S.C. § 102(e). It is believed that the amended claims specifically set forth each element of Applicant’s invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

As a preliminary matter, Applicant notes, as admitted in the outstanding Office Action, Son, Himmel et al., and Seita et al. all fail to teach a coiled enameled wire antenna. Furthermore, the Examiner has only cited Arisawa et al. as teaching a plurality of diodes and capacitors. As a result, the remarks which follow are focused on the sole reference, Furter et al., cited by the Examiner as teaching Applicant’s “coiled enameled wire” antenna.

The Examiner has cited [0001],[0002], and [0047] of Furter et al. as teaching Applicant’s “coiled enameled wire” antenna. However, Applicant has reviewed the

cited paragraphs and concluded that [0001] and [0002] only teach that the antenna is connected to the chip and describe how the antenna functions, thereby leaving only [0047] as a possible support for the Examiner's conclusion that Furter et al. teaches A "coiled enameled wire" antenna. However, [0047] merely teaches "an enameled copper wire forming the antenna can be easily connected to the packing chip...." It is important to note that, although an enameled wire is disclosed, the reference fails to teach anything about a **coiled** enameled wire. Furthermore, Figures 1-16 fail to show a coiled antenna.

Accordingly, Furter et al. cannot be said to teach: an apparatus for RFID including an antenna comprising a **coiled enameled wire**.

It is axiomatic in U.S. patent law that, in order for the Examiner to reject claims as obvious under 35 U.S.C. § 103, the Examiner must first present a *prima facie* case of obviousness, including providing teaching from the art which clearly disclose each and every feature of the claimed structure, as well as a specific motivation or suggestion from the art. Applicant submits that it is abundantly clear, as discussed above, that the references, even when combined, do not disclose each and every feature of Applicant's claims and, therefore, could not possibly support a rejection of these claims under 35 U.S.C. § 103. Absent a specific showing of a *prima facie* case, the combined references cannot be said to render any of Applicant's claims unpatentable under 35 U.S.C. § 103.

As a result, even if Son, Himmel et al., Seita et al, or Arisawa et al. were combined with Furter et al., the resulting combination would still not teach or suggest: an apparatus for RFID including an antenna comprising a **coiled enameled wire**.

Applicant submits that there is not the slightest suggestion in either Son, Himmel et al., Seita et al., Arisawa et al. or Furter et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Son, Himmel et al., Seita et al., Arisawa et al., nor Furter et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed

structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's claims.

In considering the above, the Examiner is respectfully reminded that in In re Geiger, 815 F.2d 686, 688, 2 USPQ2d, 1276, 1278 (Fed.Cir. 1987) the court stated, at page 1278: "**Obvious to try**" is not a legitimate test of patentability. *Emphasis added.*

Furthermore, in In re Wesslau, 147 U.S.P.Q. 391, 393 (CCPA 1965), the court ruled that "[t]he ever present question in cases within the ambit of 35 U.S.C. 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the **teachings** of the prior art at the time the invention was made. It is impermissible with the framework of section 103 to **pick and choose** from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (emphasis in original)

### **Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested.

Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claim 21, thereby rendering moot the outstanding rejection under 35 U.S.C. § 102. It is not believed that the foregoing amendments to claim 18 requires any further searching and/or consideration on the part of the Examiner, since such amendment merely includes incorporating the language of canceled claim 21 into claim 18. Thus, the Examiner would have inherently searched this subject matter during the previous consideration of the cancelled claim.

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Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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By:



Demian K. Jackson  
Reg. No. 57,551

TROXELL LAW OFFICE PLLC  
5205 Leesburg Pike, Suite 1404  
Falls Church, Virginia 22041  
Telephone: 703 575-2711  
Telefax: 703 575-2707

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